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27317 7590 07/23/2009
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| EXAMINER |
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ASHFORD, TAMARA R

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| ART UNIT | PAPER NUMBER |
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2627

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07/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/599,269 | Applicant(s) WAIMAN, VICTOR | |
| | Examiner Tamara Ashford | Art Unit 2627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/25/06, and 8/7/07</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

This is in response to the application filed on September 25, 2006 in which claims 1-12 are presented for examination.

1. It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried the following items:

1. Application number (checked for accuracy, including series code and serial no.).
2. Group art unit number (copied from most recent Office communication).
3. Filing date.
4. Name of the examiner who prepared the most recent Office action.
5. Title of invention.
6. Confirmation number (See MPEP § 503).

Specification

2. The disclosure is objected to because of the following informalities:

- a. Page 5, line 16, "disc stock holder 12" should be changed to --disc stock holder 12a or 12b-- in order to be consistent with the remainder of the disclosure.
- b. Page 6, line 8, "figure 3a" should be changed to --figure 3-- in order to be consistent with the remainder of the disclosure.
- c. Page 6, line 8, "circular opening" should be changed to --circular opening 15a-- in order to establish a reference sign for that shown in Fig. 3.
- d. Page 6, line 9, "disc stock holder rod 32" should be changed to --disc stock holder rod 32b-- in order to be consistent with the remainder of the disclosure.

e. Page 6, line 9, “disc stock holders 12” should be changed to --disc stock holders 12a and 12b-- in order to be consistent with the remainder of the disclosure.

f. Page 6, line 10, “rod 32” should be changed to --rod 32b-- in order to be consistent with the remainder of the disclosure.

g. Page 6, line 22, “(figure 7)” should be changed to --(figure 8)-- because the mechanical gripper is not identified in Fig. 7.

h. Page 7, line 6, “drive 41” should be changed to --drive in step 41-- in order to more clearly reference that shown in Fig. 12.

i. Page 7, line 7, “tray 42” should be changed to --tray in step 42-- in order to more clearly reference that shown in Fig. 12.

Appropriate correction is required.

Drawings

3. The drawings are objected to because of the following informalities:

a. The drawings fail to comply with 37 CFR 1.84(p)(5) because they do not include one or more following reference signs mentioned in the description. Note, for instance, “10” (disclosed in lines 2, 4, 8 and 15 on page 5, and line 5 on page 6 as an “apparatus”).

b. The drawings also fail to comply with 37 CFR 1.84(p)(5) because they include one or more reference signs not mentioned in the description. Note, for instance, “295” (Fig. 3), “470” (Fig. 3), “21a” (Fig. 4), “21b” (Fig. 4), “303.50” (Fig. 4),

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“158.40” (Fig. 10), “207” (Fig. 10), “447.37” (Fig. 10), “384” (Fig. 11), “40” (Fig. 12), and “44” (Fig. 12).

c. The drawings fail to comply with 37 CFR 1.84(p)(4) because a single reference sign has been used to designate plural distinct elements. Note, for instance, the following:

(1) Reference sign “41” has been used to designate both a “printer” (not shown in the figures, but disclosed in lines 17 and 18 on page 6) and a “Disc in drive?” step (as shown in Fig. 12, and as disclosed in lines 5-6 on page 7); and

(2) Reference sign “43” has been used to designate both a “printer tray” (not shown in the figures, but disclosed in line 20 on page 6) and a “Write Disc” step (as shown in Fig. 12, but undisclosed in the specification).

d. In Fig. 3, lead lines/arrows should be added for reference signs “12a” and “12b”.

e. In Fig. 4, reference sign “13a” should be changed to --12a-- in order to be consistent with the remainder of the disclosure.

f. In Fig. 4, lower-most reference sign “15” should be changed to --15a-- in order to be consistent with the remainder of the disclosure.

g. In Fig. 8, a lead line/arrow should be added for reference sign “24”.

h. In Fig. 9, reference sign “22” should be changed to --22b-- in order to be consistent with the remainder of the disclosure.

i. In Fig. 11, reference sign “22” should be changed to --21-- in order to be consistent with the remainder of the disclosure.

- j. In Fig. 12, "try" should be spelled --tray--.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) and/or an amendment to the specification in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 4 is objected to because of the following informalities: "data storage system of claim 4" should be changed to -- data storage system of claim 3 --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. Claim 5 recites the limitation "the printing device prints on each individual recorded disc" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim because there is no printing device mentioned in either of claims 1 or 3 from which this claim depends.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al. (US 5,914,918).

Regarding claim 1, Lee et al. (hereinafter referred as "Lee") discloses an automatic data storage system (Fig. 1, 10, and Column 1, line 10-22) enabling changing of a media storage component within a writing-reading device during a data storage process comprising a programmable automatic handler (Fig. 1, 24; and Column 2, lines 48-57, and Column 4, line 14-28) which includes a picking arm (Fig. 1, 28, and Column 2, 58-65). The media storage component is replaced according to a predefined scheduling scheme (Column 4, lines 29-56).

Regarding claim 2, Lee discloses the data storage system further comprises a printing device (Fig. 1, 40, and Column 3, lines 27-40) for writing on each media storage component throughout the storage process.

Regarding claim 7, Lee discloses the data storage system includes an in tray (Fig. 1, either of 18, 20, or 22, and Column 2, lines 33-36) and an out tray (Fig. 1, either of 18, 20, or 22) wherein the picking arm transfers the media storage component from the in tray to the writing-reading device and from there to the out tray (Column 4, lines 46-56).

Regarding claim 9, Lee discloses the handler device includes a mechanical gripper (Fig. 3, 32, and Column 4, lines 58-62).

9. Claims 1, 2, 8, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (US 6,532,198 B1).

Regarding claim 1, Miller discloses an automatic data storage system (Fig. 1, and Column 2, lines 42-48) enabling changing of a media storage component within a writing-reading device during a data storage process comprising a programmable automatic handler (Fig. 1, 58 and Column 4, lines 27-53) which includes a picking arm (Fig. 1, 56, and Column 6, lines 58-65). The media storage component is replaced according to a predefined scheduling scheme (Column 2, lines 42-48).

Regarding claim 2, Miller discloses the data storage system further comprises a printing device (Fig. 5A, 93, and Column 8, lines 56-58) for writing on each media storage component throughout the storage process.

Regarding claim 8, Miller discloses the handler device includes a vacuum suction cup (Fig. 2, 54, and Column 7, lines 19-24) for gripping the media storage component.

Regarding claim 12, Miller discloses the picking arm moves around a single axis (Fig. 3, 38 and Column 6, lines 58-65).

10. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanazawa et al. (US 20010044877 A1).

Regarding claim 1, Kanazawa et al. (hereinafter referred as “Kanazawa”) discloses an automatic data storage system (Fig. 1, 1 and Paragraph 18) enabling changing of a media storage component within a writing-reading device during a data storage process comprising a programmable automatic handler (Fig. 2, H and Paragraphs 19). Kanazawa does not explicitly disclose the handler includes a picking arm, however it can be inferred from the description of the function of the handler that a gripping device is included (Paragraph 22, and 24). The media storage component is replaced according to a predefined scheduling scheme (Paragraph 26).

Regarding claim 10, Kanazawa discloses data storage system further comprises a visual recognizer device (Paragraph 27) wherein the handler is programmed to search for a specific media storage component from the collection of media storage components, according to identified data printed on the media storage component (Paragraph 28). With respect to the limitations referring to the manner in which the search is processed, note that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647 (PTO BPAI 1987).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 6,532,198 B1) in views of Dimitri et al. (5,377,121).

Regarding claims 3 and 4, Miller discloses a software module for formatting the media storage components (Column 10, line 53 thru Column 11, line 6) as part of a copy operation. Miller does not disclose the software module generates a catalog of the stored information. Dimitri et al. (hereinafter referred as "Dimitri") discloses a data storage system that includes a software module for creating a catalog (or inventory) of the stored information (Column 6, lines 38-59). The catalog includes a list of files (referred to as "volume" see Column 4, lines 5-8) stored on each disk as well as other location and identification information (Column 6, lines 48-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate a catalog of the stored information in the invention disclosed by Miller, as with Dimitri, to enhance the disk tracking features of the storage system by providing more detailed information about the copied disks and their location, thus enabling better trouble shooting capabilities when errors occur.

Regarding claim 5, Miller discloses a printing device prints on each individual recorded disc by an integrated thermal transfer printer (Column 8, lines 51-58).

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 6,532,198 B1) in view of Dimitri (US 5,377,121) as applied to claims 3 and 5 above, and further in view of Kahle (US 5,518,325).

Regarding claim 6, Miller discloses information is printed on each disc (see claim 5 discussion above), however Miller is silent on the contents of the printed information. Kahle discloses a disk label with various descriptive disc information printed on it including a date (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include descriptive information on the label printed on each disk in the data storage system disclosed by Miller, as taught by Kahle, to provide the end user with useful information about the contents of the disc.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US 5,914,918).

Regarding claim 11, Lee discloses the picking arm of the auto handler moves along guide shafts (Fig. 1, 26, and Column 2, lines 48-53), not a rack. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a rack rather than guide shafts to move the picking arm linearly as a matter of design choice as both are commonly used in the art for this purpose and it appears that the invention would perform equally well with either.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara Ashford whose telephone number is (571)270-5877. The examiner can normally be reached on Mon-Fri 7:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (571)272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. A./
Examiner, Art Unit 2627

/Craig A. Renner/
Primary Examiner, Art Unit 2627